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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,264	11/12/1999	KUNIHICO MIWA	JA9-98-171	1450

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EXAMINER

BACKER, FIRMIN

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/439,264

Applicant(s)

MIWA ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 1999.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other:  |

## DETAILED ACTION

This is in response to a letter for patent filed on November 12<sup>th</sup>, 1999 in which claims 1-20 are presented for examination. Claims 1-20 are pending in the letter.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mott et al (U.S. Patent No 6,170,060).

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3. As per claim 1, Mott et al teach a method of recording digital data onto a medium, comprising detecting from digital data any additional information electronically embedded therein, if the additional information is detected, then performing access control for the digital data using the additional information, scrambling the digital data, and recording the scrambled digital data onto a medium (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

4. As per claim 2, Mott et al teach a method of determining whether copying/recording of the digital data is to be stopped or continued (*see fig 4, column 1 lines 45-65*).

5. As per claim 3, Mott et al teach a method further comprises a step of embedding a copy mark into the digital data in accordance with a content of the additional information (*see column 2 lines 9-19*).

6. As per claim 4, Mott et al teach a method wherein the electronically embedded additional information comprises such additional information that is embedded through a transformation of the data itself (*see column 2 lines 9-19*).

7. As per claim 5, Mott et al teach a method performing playback control of digital data recorded onto a medium, comprising descrambling scrambled digital data, detecting from the digital data any additional information and copy mark electronically embedded therein, and

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performing playback control of the digital data using the additional information and copy mark  
(*see column 5 lines 15-31, 7 line 24-8 line 54*).

8. As per claim 6, Mott et al teach a method wherein the electronically embedded additional information comprises such additional information that is embedded through a transformation of the data itself (*see column 2 lines 9-19*).

9. As per claim 7, Mott et al teach a video driver card for creating digital data, comprising an encoder for receiving analog data and outputting digital data, means for detecting any additional information electronically embedded in the digital data, means for adding a copy mark to the additional information in accordance with the additional information, and means for scrambling the digital data with the additional information (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

10. As per claim 8, Mott et al teach a video driver card wherein the digital data is an MPEG stream, and wherein the encoder is an MPEG encoder (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

11. As per claim 9, Mott et al teach a video driver card wherein the electronically embedded additional information comprises such additional information that is embedded through a transformation of the data itself (*see column 2 lines 9-19*).

12. As per claim 10, Mott et al teach a video driver card for decoding digital data, comprising means for descrambling scrambled digital data, means for detecting from the digital data any additional information and copy mark electronically embedded therein, and means for performing playback control of the digital data using the additional information and copy mark (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

13. As per claim 11, Mott et al teach a video driver card wherein the digital data is an MPEG stream, and wherein the means comprises means for determining whether or not outputting of an MPEG stream is to be performed and for outputting a desired MPEG stream (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

14. As per claim 12, Mott et al teach a video driver card wherein the electronically embedded additional information comprises such additional information that is embedded through a transformation of the data itself (*see column 2 lines 9-19*).

15. As per claim 13, Mott et al teach a video driver card further comprises means for adding a copy mark to the digital data in accordance with the additional information and copy mark and for outputting the digital data (*see column 2 lines 9-19*).

16. As per claim 14, Mott et al teach a recorder for recording digital data onto a medium, comprising an encoder, for receiving analog data and outputting digital data, means for detecting

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any additional information electronically embedded in the digital data, means for adding a copy mark to the additional information in accordance with the additional information, and means for scrambling the digital data, and means for recording the scrambled digital data onto a medium (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

17. As per claim 15, Mott et al teach a recorder wherein the digital data is an MPEG stream, and wherein the encoder is an MPEG encoder (*see fig 4, column 1 lines 45-65*).

18. As per claim 16, Mott et al teach a recorder wherein the electronically embedded additional information comprises such additional information that is embedded through a transformation of the data itself (*see column 2 lines 9-19*).

19. As per claim 17, Mott et al teach a player for playing back digital data recorded onto a medium, comprising means for reading the digital data from the medium, means for descrambling the digital data, means for detecting from the digital data any additional information and copy mark electronically embedded therein, and means for performing playback control of the digital data using the additional information and copy mark (*see abstract, fig 1-3, summary of the invention, column 5 lines 15-39, 66-6 lines 5, 6 line 36-7 line 42*).

20. As per claim 18, Mott et al teach a player wherein the digital data is an MPEG stream, and wherein the means comprises means for determining whether or not outputting of an MPEG

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stream is to be performed and for outputting a desired MPEG stream (*see fig 4, column 1 lines 45-65*).

21. As per claim 19, Mott et al teach a player wherein the means further comprises means for adding a copy mark to the digital data in accordance with the additional information and copy mark and for outputting the digital data (*see column 2 lines 9-19*).

22. As per claim 20, Mott et al teach a player wherein the electronically embedded additional information comprises such additional information that is embedded through a transformation of the data itself (*see column 2 lines 9-19*).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

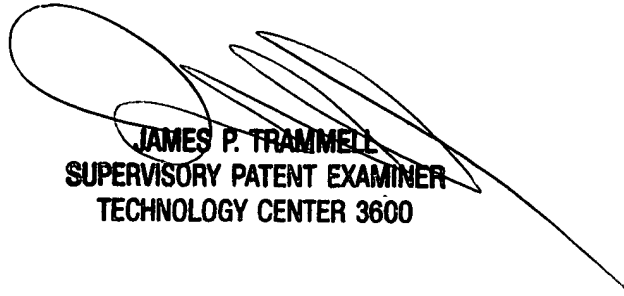


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Firmin Backer  
June 18, 2002



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
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